

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

0063-127001/BU3385

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on \_\_\_\_\_

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Application Number

10/776,531

Filed

February 12, 2004

First Named Inventor

Shrjie Tzeng

Art Unit

2445

Examiner

Vivek V. Krishnan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/William G. Hughes, Reg. No. 46,112/

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Signature

William G. Hughes

Typed or printed name

☒ attorney or agent of record.  
Registration number 46,112

202-470-6452

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

September 17, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Shrjie Tzeng	Examiner: Vivek V Krishnan
Serial No.:	10/776,531	Group Art Unit: 2445
Filed:	February 12, 2004	Docket No.: 0063-127001/BU3385
Title:	SOURCE IDENTIFIER-BASED TRUNKING FOR SYSTEMS OF NETWORK DEVICES	

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**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant has reviewed the Advisory Action mailed on September 2, 2010. In the Final Office Action of March 17, 2010, some or all of pending claims 1, 6, 8-10, 16-20, 24-28, and 30 were rejected under (1) 35 U.S.C. 112, first paragraph, (2) 35 U.S.C. 112, second paragraph, and (3) 35 U.S.C. 103. In the Response filed August 17, 2010, Applicant amended independent claims 1 and 6 based on the Examiner's comments and in response to the rejections under 35 U.S.C. 112, second paragraph for reasons related to alleged lack of definiteness, and not for reasons related to patentability related to the cited prior art. However, the Advisory Action incorrectly states that the amendments would not be entered because they "raise new issues that would require further consideration and search," and do not "place the application in better form for appeal by materially reducing or simplifying the issues for appeal." These positions effectively ignore all of Applicant's arguments related to the substance of the rejections, and are erroneous on their face. Specifically, first, the amendments are merely clarifying and do not require further consideration or search. Second, the amendments do place the application in better condition for appeal because they obviate the alleged indefiniteness under 35 U.S.C. 112, second paragraph. MPEP 714.13 clearly states that amendments should be entered which remove issues for appeal, and which follow Examiner suggestions. Third, the Advisory Action effectively uses the issue of whether to enter the amendments as a "strawman" argument to avoid, and in fact does avoid, considering any of Applicant's substantive arguments, in direct violation of MPEP 707.07(f), which states, with emphasis added, "(w)here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Therefore, by virtue of the present Request, Applicant requests that the amendments to claims 1 and 6 be entered to thereby obviate the rejections under 35 U.S.C. 112, second paragraph and place the application in better condition for appeal. Having thereby removed the strawman which permitted disregard of Applicant's substantive arguments and deprived Applicant of the

opportunity to rebut the Examiner's position on appeal, Applicant requests that the arguments of record be considered in their entirety, and the rejections under 35 U.S.C. 112, first paragraph and 35 U.S.C. 103 be withdrawn, and the application passed to allowance.

Specifically, claims 1, 6, 8-10, 16-20, and 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Final Office Action of March 17, 2010 maintained this rejection over Applicant's previous arguments by stating, "applicant's specification never defines forwarding normally in the manner recited in the claims." See Final Office Action of March 17, 2010, paragraph 1. However, as pointed out in Applicant's response, Applicant's claims never recite "forwarding normally," and instead recite, e.g., as in claim 1, "forwarding the frame from the first network device to a network device of the first side to which the frame is destined." As described in Applicant's specification and identified in Applicant's previous responses of November 23, 2009 and August 17, 2010, Applicant's specification discloses and describes this claim language and demonstrates that Applicant was in possession thereof. For example, in the specific example of FIG. 2, if the frame is received at device 210 and is not destined for a member on the other side (i.e., not for either device 220, 221), then the frame is destined for the device 211 on the same side of the assembly as the device 210. Then, the frame may be forwarded using the expansion port (exp tx) of the device 210, as clearly shown and described with respect to FIG. 2. That is, Applicant submits that FIG. 2 clearly illustrates the use of the expansion ports (exp tx of device 210 and exp rx of the device 211) to forward frames between the devices 210, 211. Such disclosure is more than sufficient to provide written description for the actual recited claim language of claim 1. To argue otherwise is to take the position that one of skill in the art would not have believed that the Applicant was capable of (i.e., in possession of the ability of) forwarding frames between devices 210, 211 using the illustrated/described ports exp tx and exp rx. Further, as referenced above, Applicant included these arguments in the Response of August 17, 2010, and yet the Advisory Action of September 2, 2010 completely ignores these arguments, in direct violation of MPEP 707.07(f), as cited above.

Further, claim 1, 6, 8-10, 16-20, and 24-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0027908 to Kalkunte et al. (hereinafter "Kalkunte") in view of U.S. Patent Publication No. 2003/0016624 to Bare (hereinafter "Bare"). For example, claim 1 recites, "if the frame is destined for the second network device (of the second

side), determining a path for forwarding the frame to the second side, the path being determined based on achieving a minimized forwarding latency for forwarding the frame to the second network device and including the first high-speed port of the first network device.” The present rejection of claim 1 (e.g., paragraph 11 of the Final Office Action of March 17, 2010) admits that Kalkunte does not disclose these elements of claim 1 as reproduced above. However, the rejection asserts that, Bare discloses “determining the path based on achieving a minimized forwarding latency,” with reference to paragraph 214 of Bare. The Final Office Action goes on to state in paragraph 11 that “(i)t would have been obvious ...to modify determining a path in a fabric switch, as disclosed by Kalkunte, to including minimizing forwarding latency, as disclosed by Bare, in order to incorporate more efficient methods of path determination known in the art.”

Thus, Applicant submits that it is apparent that the Final Office Action completely fails to provide any articulated line of reasoning as to how the proposed modification of Kalkunte by Bare would have been made in order to arrive at the invention of claim 1. That is, as just reproduced, the Final Office Action attempts to state “why” the proposed modification would have been made (i.e., “to incorporate more efficient methods of path determination”), but, aside from the deficiencies and insufficiencies of this aspect of the rejection as noted below, such a statement clearly disregards the requirement to provide “...objective evidence teaching how to modify the prior art components to achieve the individual elements of the claim at issue, and providing objective evidence teaching how to combine the modified individual components such that the claim, as a whole, is obtained.” MPEP § 2141; MPEP § 2143, emphasis added. For example, the rejection does not identify any particular element of Kalkunte that would have been modified by any particular element or concept of Bare, or any element of Bare which would have been added to Kalkunte (much less how such an addition would have been executed). Instead, the Office Action merely makes a conclusory statement alleging *why* the proposed modification/combination would have been made, and therefore fails on its face to provide the type of articulated reasoning required in *KSR v. Teleflex*, 550 U. S. \_\_\_\_ (2007); No. 4-1350 (April 30, 2007).

If the rejection were to explain the “how” of the proposed combination, Applicant submits that it would rapidly become clear that the proposed “why” of the proposed combination is also incorrect. For example, the proposed “why” is “...to incorporate more efficient methods of path determination...,” as described above. However, Kalkunte discloses that a port of a trunked group

may be determined using a hash value for a “switch-on-a-chip solution for a self-routing fabric ... to maximize the ability of packet-forwarding at linespeed...” See Kalkunte, paragraph 0010. In contrast, Bare discloses, “methods and structures for rapidly identifying an alternate path to be used by a switch for forwarding of traffic after failure of a preferred path. See Bare, paragraph 0032. “A potential alternate path is used to send a query message to a neighboring network switch to determine if a path to the identified devices is available ... such query messages are propagated through all intermediate network switches between the switch sensing the failed port up to the identified network device. Acknowledgment messages are returned to verify potential availability of an alternate path...” See Bare, Abstract. Even if Bare were to teach selection of an alternate path based in part on latency considerations, Applicant submits that Kalkunte is clear that hash values are used to select a trunked port, and modifying Kalkunte to use the method of Bare (e.g., using query messages in response to a failed port) to select a trunked port would therefore change the principle of operation of Kalkunte, in contradiction to MPEP 2143.01(VI), so that Kalkunte clearly teaches away from the proposed combination as set forth in MPEP 2141.02. Moreover, the rejection makes no showing as to whether any modification of Kalkunte based on Bare would be feasible or workable in obtaining a “more efficient method of path determination,” as alleged in the rejection, in the “switch-on-a-chip solution for a self-routing fabric ... to maximize the ability of packet-forwarding at linespeed” environment of Kalkunte.

Consequently, Applicant submits that claim 1 is allowable for at least these reasons, so that dependent claims 16, 17, 19, 20, and 30 are believed allowable for at least the same reasons. Independent claims 6 and 24 recite the same or similar features discussed above, and are thus believed allowable for the same or similar reasons, along with their respective dependent claims

Respectfully submitted,

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Date: September 17, 2010

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